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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,327	09/24/2003	Toshiki Taguchi	Q77655	2308

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EXAMINER

KLEMANSKI, HELENE G

ART UNIT PAPER NUMBER

1755

DATE MAILED: 09/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/668,327

Applicant(s)

TAGUCHI, TOSHIKI

Examiner

Helene Klemanski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-8 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Claims 1 and 3 have been amended, none of the claims have been deleted and new claims 6-8 have been added. Hence, claims 1-8 are pending in the application.
2. The 102(b) rejection over Yamanouchi et al. (US 2002/0107301) as set forth in the previous Office Action dated March 28, 2005 has been overcome by applicant's amendments and is now withdrawn.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-8 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3 and 14 of copending Application No. 10/806,424. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application overlap said patent claims and would be obvious thereby.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicant's should note that the ODP rejection in the previous Office Action dated March 28, 2005 incorrectly stated the conflicting claims of the copending application as 1 3 and 14. The ODP should have read claims 1, 3 and 14 (as reflected above).

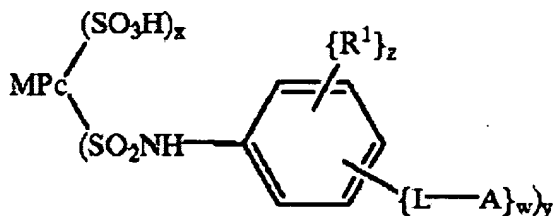
Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kenworthy et al. (US 6,237,097).

Kenworthy et al. teach an ink jet ink composition comprising 70-99.9 parts by weight of a liquid medium and 0.01-30 parts by weight of a dye of the formula



wherein M represents a metal or H; Pc represents a phthalocyanine nucleus; L represents an optionally substituted C₁₋₃₀ hydrocarbyl group; A represents an amino or an optionally substituted C₁₋₃₀ hydrocarbyl group comprising at least one protonable

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nitrogen with the proviso that A does not comprise an alkyl group substituted by at least one of a hydroxy, carboxy or sulfo group; R^1 represents an optional substituent or an optionally substituted C_{1-15} hydrocarbyl group; z represents an integer from 0-4; w represents an integer from 1-5 and $z+w$ is from 1-5 and x and y each independently represent a non-zero number and the mean sum of $x+y$ is from about 1 to about 6. The above dyes may be in the form of a salt such as their sodium, lithium, potassium, ammonium and substituted ammonium salts. Kenworthy et al. further teach that the above dyes are converted to their purified ammonium salts by filtration and desalination by reverse osmosis. The dissolved sodium salt was converted into the ammonium salt by ion-exchange and the resulting ammonium salt dye was used directly in an ink composition. The inks are printed onto plain paper by a thermal ink jet printer and give bright cyan prints with good optical density and excellent water and light fastness. See col. 2, line 25 – col. 3, line 5, col. 3, line 50 – col. 4, line 23, col. 5, lines 8-32, col. 6, lines 52-57, col. 7, lines 4-6, col. 11, line 60 – col. 12, line 22 and claims 1, 4-7, 12 and 13. Kenworthy et al. fail to specifically exemplify a phthalocyanine dye containing a lithium counter ion as claimed by applicants.

Therefore, it would have been obvious to one having ordinary skill in the art to use the specific a phthalocyanine dye containing a lithium counter ion as claimed by applicants as Kenworthy et al. also discloses the use of these phthalocyanine dyes but fails to show an example incorporating them.

The only limitation in the claims not found by the examiner is the total amount of a cation in the ink. However, this limitation is considered obvious because there does

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not appear to be any reason why the cited reference would not contain an ink composition with applicants claimed amount of cations.

It is the examiners position that by converting the above dyes to their purified ammonium salts by filtration, reverse osmosis and/or ion-exchange the amount of the cations in the ink composition of Kenworthy et al. would also be reduced as claimed by applicants.

Response to Arguments

7. Applicant's arguments filed June 28, 2005 have been fully considered but they are not persuasive.

In the response filed June 28, 2005, applicants indicated that claims 13 and 14 of the copending Application No. 10/806,424 did not teach the present claims and the ODP should be withdrawn. The examiner agrees that claims 13 and 14 of the above copending application does not teach the present claims, however, the indicated copending claims should have been 1, 3 and 14. Claim 1 of copending Application No. 10/806,424 discloses an ink comprising dye, water, water-soluble organic solvent and betaine wherein the total weight of inorganic ions present in the ink is 2 wt% or less and claim 14 discloses that the dye is a phthalocyanine dye with $-\text{SO}-$, $-\text{SO}_2-$, $-\text{CO}-$ and/or $-\text{CO}_2-$ groups as claimed by applicants. See also paras. 0069-0082. Therefore, it is the examiner's position that the ink containing the phthalocyanine dye of the above copending application broadly encompasses the inkjet recording ink as presently

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claimed and a terminal disclaimer is needed to overcome this rejection. The examiner will consider the terminal disclaimer if it is filed in response to this Office Action.

Applicants argue that the Kenworthy et al. reference does not teach a phthalocyanine dye that is water-soluble and has a lithium counter ion. The examiner disagrees since the Kenworthy et al. reference specifically states that the phthalocyanine dyes contain at least one SO_3H group (i.e. water-soluble group) and may be in the form of their lithium salts. See col. 2, lines 25-36, col. 5, lines 5-26, col. 11, line 56 – col. 12, line 22 and claims 1 and 4-7.

Applicants also argue that the Kenworthy et al. reference does not suggest that the phthalocyanine dye improves the stability of the ink. The examiner disagrees since Kenworthy et al. specifically discloses that the printed matter has good optical density and excellent water and light-fastness. Therefore, it is the examiner's position that the ink of Kenworthy et al. is very stable to be able to provide such properties in the printed matter.

Applicants also argue that the Kenworthy et al. reference does not suggest that bronze luster of the printed matter would be decreased by controlling the amount of the cations in the ink composition to be less than 0.5 wt% as claimed by applicants. The examiner agrees, however, it is the examiner's position that the ink of Kenworthy et al. would obviously possess a low amount of inorganic cations (and decreased bronze luster) since the salt form of the phthalocyanine dye is filtered, desalinated by reverse osmosis and/or passed through an ion-exchange column (see col. 11, line 60 – col. 12, line 7) to produce a purified dye absent results to the contrary.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

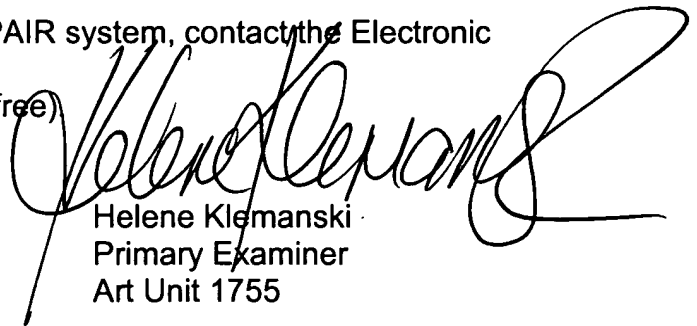
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helene Klemanski whose telephone number is (571) 272-1370. The examiner can normally be reached on Monday-Friday 5:30-2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Helene Klemanski
Primary Examiner
Art Unit 1755



HK

August 29, 2005